



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/825,972

04/16/2004

Andrew Michael Allen

291010-00036

8222

3705 7590 09/16/2009
ECKERT SEAMANS CHERIN & MELLOTT
600 GRANT STREET
44TH FLOOR
PITTSBURGH, PA 15219

EXAMINER

MANOHARAN, MUTHUSWAMY GANAPATHY

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

09/16/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/825,972
Filing Date: April 16, 2004
Appellant(s): ALLEN ET AL.

Andrew Michael Allen et al.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/26/2009 appealing from the Office action mailed 9/30/2008.

(1) Real Party in Interest

A statement identifying by name of the real party of interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments

No amendment has been filed after the Non-final rejection.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The Appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 5535426	Leigh et al.	7-1996
US 2005/0113123	Torvinen et al.	5-2005

US 7072941	Griffin et al.	7-2006
US 6097942	Laiho	8-2000
US 2004/0198376	Chandhok et al.	10-2004
US 2002/0126701	Requena	9-2002
WO 01/97539	Amir et al.	12-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 65, 68-71, 74, 75, 79-81, 83, 84, 86, 87, 94-100, 103-110, 113, 114 and 116 rejected under 35 U.S.C. 102(e) as being anticipated by over Torvinen et al. (hereinafter Torvinen) (US 2005/0113123)

Regarding **claim 65**, Torvinen teaches a method of creating and managing a group of mobile stations for a communication session in a communications network, the communication session being one in which users of respective mobile stations communicate with one another, the method comprising:

Publishing information about one or more particular users of respective mobile stations to the communications network (item 510 in Figure 5, "location information is communicated by participating terminals", Paragraph [0062], "application management component may receive ... chat group definitions", Paragraph [0068]; Further the capability information is known to the network ("group management server is adapted to compare location information and capability information associated with each of the plurality of terminals", Paragraph [0011]) and requires information related to the capability being published by the users of the mobile stations at the application management component, "the qualifying terminals have previously met group service definitions, Paragraph [0014], therefore, the information is provided to the network by the mobile stations); and

receiving at least one rule defining a member of the group, the at least one rule defining group members based on criteria comprising published information about respective users of mobile stations, the at least one rule being received in association with a group address (Paragraph [0013], lines 8-10; Paragraph [0016], lines 8-13); and

dynamically populating the group with members, the populating comprising: determining mobile stations having respective users that matches the published information criteria of the at least one rule ("wish to form a group with each other for a certain time, purpose and location", Paragraph [0029], lines 7-11); and populating the group with the mobile stations having respective users matches the published information criteria of the at least one rule (Paragraph [0014], lines 9-14).

Regarding **claim 68**, Torvinen further teaches the method of claim 65, wherein the criteria of the at least one rule comprises location information of respective users of mobile stations (Paragraph [0029], line 5; Paragraph [0016], lines 8-12). The limitation regarding publication is already discussed in claim 65.

Regarding **claim 69**, Torvinen teaches the method of claim 65, wherein the at least one rule is further defined by a group of pre-selected mobile stations from which to define the group ("**qualifying terminals have previously met the group service definitions**", Paragraph [0014]).

Regarding **claim 70**, Torvinen teaches the method of claim 65, wherein the at least one rule further defined by additional criteria comprising location information about mobile stations managed by the communications network, the step of dynamically populating the group further comprising:

determining if the location information about the one or more particular mobile stations matches the location information criteria of the at least one rule (Paragraph [0016], lines 8-12); and wherein the group is populated with members consisting of mobile stations having respective users with published information on the communications network and location information that matches the criteria and location information criteria of the at least one rule respectively ("wish to form a group with each other for a certain time, purpose and location", Paragraph [0029], lines 7-11Paragraph [0014], lines 9-14). The limitation regarding publication is already discussed in claim 65.

Regarding **Claim 71**, Torvinen further teaches the method of claim 70, wherein the location information about the one or more particular mobile stations is stored on one or more network servers (Figure 3, Paragraph [0050]).

Regarding **Claim 74**, Torvinen teaches the method of claim 65, further comprising sending a notification to each member of the group in response to the populating, the notification identifying the respective mobile station or its user as a member of the group (Paragraph [0014], lines 7-9).

Regarding **claim 75**, Torvinen teaches the method of claim 74, wherein the notification identifying at least some of the other mobile stations or users of respective membership as members of the group (Paragraph [0014], lines 7-9).

Regarding **claim 79**, Trovinen further the method of claim 65, comprising receiving two or more rules defining a member of the group, the two or more rules being received in association with a common group address, the group being dynamically populated with members in accordance with the two or more rules and at least the published information about the one or more particular users on the communications network (Abstract). Published information has been discussed in claim 65.

Regarding **claim 80**, Torvinen further teaches the method of claim 79, wherein one of the two or more rules is defined by criteria comprising location information managed by the communications network, the group being dynamically populated with members in accordance with the two or more rules, published information about one or more particular users on the communications

Art Unit: 2617

network, and location information about one or more particular mobile stations of the communications network (Abstract). Published information has been discussed in claim 65.

Regarding **Claim 81**, Torvinen teaches the method of claim 65, wherein the step of determining comprises requesting and receiving notification of one or more particular mobile stations which match the at least one rule (Paragraph [0063,65]).

Regarding **claim 82**, Torvinen teaches the method of claim 81, wherein the step of determining comprises requesting and receiving notification that no particular mobile stations match the at least one rule (Paragraph [0060], lines 6-9; Paragraph [0071], lines 12-19).

Regarding **claim 83**, Torvinen teaches the method of claim 81, further comprising subscribing to at least one server which provides notification that one or more particular mobile stations match the at least one rule ("notification to qualifying terminals", Paragraph [0064]).

Regarding **claim 84**, Torvinen teaches the method of claim 83, further comprising determining an address for each of the at least one server for subscribing, the address being determined from a resource list of addresses for such servers (Paragraph [0066]).

Regarding **claim 86**, Torvinen teaches, the method of claim 65, further comprising maintaining the group, removing one or more particular mobile stations or users as a member of the group in accordance with the at least one rule (Paragraph [0071])

Regarding **claim 87**, Torvinen teaches the method of claim 86, further comprising receiving notification that one or more particular mobile stations or users no longer matches the at least one rule (Paragraph [0071]).

Claim 113 is rejected for the same reason as set forth in claim 65.

Claim 114 is rejected for the same reason as set forth in claims 65 and 70.

Regarding **claim 115**, Torvinen teaches the method of claim 114, wherein the publishing step comprises publishing an interest in participating in a particular dynamic group or an interest in participating in dynamic groups generally (Paragraph [0057]).

Claim 116 is rejected for the same reason as set forth in claim 67.

Regarding **claim 117**, Trovinen teaches the method of claim 114, wherein mobile stations are determined from a subset of pre-selected mobile stations or pre-selected users of the mobile stations ("location based group service", "previously met the group service definition", "form a group with each other fro a certain time, purpose and location", Paragraphs [0014,0029]; "location based gaming", "gaming enabled terminals"; Paragraph [0053]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2617

Claims 66-67, 72 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torvinen et al. (hereinafter Torvinen) (US 2005/0113123) in view of Amir (WO 01/97539).

Regarding **claim 66**, Torvinen teaches all the particulars of the claim except, wherein the published information criteria of the at least one rule comprises at least one characteristic of respective users of mobile stations. However, Amir teaches in an analogous art, the method, wherein the published information criteria of the at least one rule comprises at least one characteristic of respective users of mobile stations (Abstract). Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to use the method, wherein the published information criteria of the at least one rule comprises at least one characteristic of respective users of mobile stations. This type of method it acts as a filter, since it tries to organize group among subscribers with similar characteristic.

Regarding **claim 67**, Torvinen teaches all the particulars of the claim except wherein the published information criteria of the at least one rule comprises at least one personal preference and/or at least one common interest of respective users of mobile stations. However, Amir teaches in an analogous art, the method, wherein the published information criteria of the at least one rule comprises at least one personal preference and/or at least one common interest of respective users of mobile stations (Abstract, Page 9, lines 18-29). Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to use the method, wherein the published information criteria of the at least one rule comprises at least one personal preference and/or at least one

Art Unit: 2617

common interest of respective users of mobile stations. This type of method it acts as a filter, since it tries to organize group among subscribers with similar characteristic.

Regarding **claim 72**, Torvinen teaches all the particulars of the claim except the method of claim 70, wherein the location information about the one or more particular mobile stations is stored on one or more network servers in Xtensible Markup Language (XML) format. However, Amir teaches in an analogous art, method of claim 70, wherein the location information about the one or more particular mobile stations is stored on one or more network servers in Xtensible Markup Language (XML) format (Page 5, lines 14-20). Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to use method of claim 70, wherein the location information about the one or more particular mobile stations is stored on one or more network servers in Xtensible Markup Language (XML) format. This modification helps to facilitate the sharing of data across different information systems, particularly systems connected via the Internet.

Claim 73 is rejected for the same reason as set forth in claim 72.

Claims 76-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torvinen et al. (hereinafter Torvinen) (US 2005/0113123) in view of Griffin et al. (hereinafter Griffin) (US 7072941).

Regarding **claim 76**, Torvinen teaches all the particulars of the claim except the method, wherein the notification excludes anonymous members of the group. However, Griffin teaches in an analogous art wherein the notification excludes anonymous members of the group (Col. 9, lines 40-44). Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to use the method wherein the notification

Art Unit: 2617

excludes anonymous members of the group in order to have selective notification to only members of the group.

Regarding **claim 77**, Torvinen teaches all the particulars of the claim except the method, further comprising sending a notification to each member of the group identifying an anonymous member of the group when the anonymous member actively participates in the group. However, Griffin teaches in an analogous art except the method, further comprising sending a notification to each member of the group identifying an anonymous member of the group when the anonymous member actively participates in the group (Col. 9, lines 40-44). Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to use the method, further comprising sending a notification to each member of the group identifying an anonymous member of the group when the anonymous member actively participates in the group. This limitation is well known in the art.

Regarding **claim 78**, Torvinen teaches all the particulars of the claim except anonymous members. However, Griffin teaches in an analogous art, anonymous members (Col. 9, lines 40-44). Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to have the anonymous members in the group with temporary ID's. This limitation is well known in the art.

Claim 85 is rejected under 35 U.S.C. 103(a) as being unpatentable over Torvinen in view of Laiho (US 6097942).

Regarding **claim 85**, Torvinen teaches all the particulars of the claim except the method, further comprising receiving notification of individual matching mobile stations

Art Unit: 2617

as the individual matching mobile stations are determined by said at least one server to hasten the populating. However, Laiho teaches in an analogous art except the method of claim comprising receiving notification of individual matching mobile stations as the individual matching mobile stations are determined by said at least one server to hasten the populating (Abstract, lines 24-31; Col. 2, lines 33-41; lines 57-60). Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to use the method of claim comprising receiving notification of individual matching mobile stations as the individual matching mobile stations are determined by said at least one server to hasten the populating. This modification provides an efficient method of managing group communication.

Claim 86 is rejected under 35 U.S.C. 103(a) as being unpatentable over Torvinen in view of Chandhok et al. (hereinafter Chandhok) (US 2004/0198376).

Regarding **claim 86**, Torvinen teaches all the particulars of the claim except the method of claim 65, further comprising receiving a change of the at least one rule and managing the members of the dynamic group in accordance with the change wherein the step of managing comprises at least one of adding and removing members to the group. However, Chandhok teaches in an analogous art, the method of claim 65, further comprising receiving a change of the at least one rule and managing the members of the dynamic group in accordance with the change wherein the step of managing comprises at least one of adding and removing members to the group (Paragraph [0022], line 6-7). Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to use the method of claim 65, further comprising receiving a change

Art Unit: 2617

of the at least one rule and managing the members of the dynamic group in accordance with the change wherein the step of managing comprises at least one of adding and removing members to the group. This modification makes the rule very flexible (dynamic).

Claims 89-92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torvinen (US 2005/0113123) in view of Leigh et al. (US 5535426).

Regarding **claim 89** Torvinen teaches all the particulars of the claim except the method further comprising extending a search for mobile stations matching the at least one rule. However, Leigh teaches in an analogous art, the method of claim 37, further comprising extending a search for mobile stations matching the at least one rule (Abstract, Col. 1, lines 21-50; Col. 2, lines 10-21; Col. 3, lines 17-24). Therefore, it would be obvious to one of ordinary skill in the art, at the time of invention to use the method of extending a search for mobile stations matching the at least one rule. This modification provides a way of talk group participation across multiple sites.

Regarding **claim 90**, Leigh further teaches, the method of claim, wherein the subscribing to at least one server extends the search to at least one of different domains and networks (Abstract, Col. 1, lines 21-50; Col. 2, lines 10-21; Col. 3, lines 17-24).

Regarding **claim 91**, Torvinen further teaches one or more of the atleast one server to one or more other such servers (Figure 3; Paragraphs [0050-0052]). Torvinen did not teach specifically the method further comprising

Art Unit: 2617

extending a search for mobile stations matching the pre-defined rule. However, Leigh teaches in an analogous art, the method of claim 37, further comprising extending a search for mobile stations matching the pre defined rule (Abstract, Col. 1, lines 21-50; Col. 2, lines 10-21; Col. 3, lines 17-24). Therefore, it would be obvious to one of ordinary skill in the art, at the time of invention to use the method of extending a search for mobile stations matching the predefined rule. This modification provides a way of talk group participation across multiple sites.

Regarding **claim 92**, Leigh further teaches the method of wherein the subscribing extends the search for mobile stations to include a home network and a roaming network of a first mobile station (Abstract, Col. 1, lines 21-50; Col. 2, lines 10-21; Col. 3, lines 17-24).

Claim 93 is rejected under 35 U.S.C. 103(a) as being unpatentable over Torvinen (US 2005/0113123) in view of Requena (US2002/0126701).

Regarding **claim 93**, Torvinen further teaches the method of claim 65, wherein the method comprises: receiving a request from a first mobile station to initiate a group communication with at least one second communication device proximate said first mobile station (Paragraph [0055], lines 5-11; Paragraph [0057], lines 1-8). Torvinen did not teach specifically the method, wherein the group comprises a mayday group and the method comprises: populating the mayday group with particular ones of the mobile stations determined response pre-defined rules for the mayday group (Paragraph

Art Unit: 2617

[0060], lines 9-21) However, Requena teaches in an analogous art populating the mayday group with particular ones of said mobile stations determined response pre-defined rules for the mayday group (Paragraph [0123], line 6). Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to have the method of populating the mayday group with particular ones of said mobile stations determined response pre-defined rules for the mayday. This modification enhances the services provided to the mobile stations.

Claims 94-102 are rejected for the same reason as set forth in **claims 65-73**.

Claims 103-112 are rejected for the same reason as set forth in **claims 65 and 65-73 respectively**.

(10) Response to Argument

Rejection under 35 U.S.C. 102(e) of Claims 65, 68-71, 74, 75, 79-81, 83, 84, 86, 87, 94-100, 103-110, 113, 114, 116 and 117 over Torvinen (US 2005/0113123).

Appellant argues on Page 13 that Torvinen does not teach or suggest publishing information about one or more particular users of respective mobile stations to the communications network. Examiner respectfully disagrees.

Torvinen teaches (Paragraph [0068]) the management component receives service parameters from e.g., organizing terminal. The service parameters represent location based group formation criteria, region of interest, session interval and mode of

Art Unit: 2617

contact for participants chat group definitions etc. Torvinen further teaches (Paragraph [0013]) the mobile terminal communicating the session area (where the location based group sessions are offered) and criteria to the network.

Torvinen also teaches (Paragraph [0015]), the receiving content from the organizing terminal is being shared with the participating members of the group). Note the claimed language merely define publishing information about one or more particular users of respective mobile stations to the communication network. Thus, the publishing information can be read by the service parameters as taught in Torvinen.

In view of the above, it is clear that Torvinen teaches the claimed limitation publishing information about one or more particular users of respective mobile stations to the communications network.

Appellant's further arguments on pages 13-14, that are related to previous office actions which are not relied upon. However, it is to be noted that after further reviewing the prior art (Torvinen), examiner noticed that Torvinen teaches the claimed limitation stated above.

Torvinen teaches the at least one rule is defined by criteria ("the defining criteria", Paragraph [0013]) comprising published information about respective users of mobile stations (the management component receives service parameters from e.g., organizing terminal. The service parameters represent location based group formation criteria, region of interest, session interval and mode of contact for participants chat group definitions etc", Torvinen: Paragraph [0068]) and is received in association with a group address ("providing the potential group attendees with an address of server within the

Art Unit: 2617

network that is hosting the location based group session. The address is then used by the potential group attendees to access the server", Torvinen: Paragraph [0016])"

Torvinen teaches the group is then dynamically populating with members ("cell based group formation through inclusion of each active mobile terminal that is currently sharing the same cell, e.g., mobile terminal group, Paragraph [0039]) having published information that matches the published information criteria of the at least one rule ("wish to form a group with each other for a certain time, purpose and location", Torvinen: Paragraph [0029], lines 7-11).

In response to appellant's argument on Page 15 the published information, in contrast, is information published by a mobile station on behalf of a user to the communication network, thereby making such information available to others to view, it is to be noted that the features upon which applicant relies on are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are read into the claims. See *In re van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Appellant argues (Page 16, lines 7-9) that "examiner's need to rely on second reference to find published information about one or more users of respective mobile stations within the meaning given to the term by the present application".

Examiner relied on reference by Amir for the rule comprising characteristics of respective users of the mobile stations.

Appellant argues that (Page 16, lines 17-23) that "Location information" as that term used in Torvinen is not published information to a communication network nor is it

Art Unit: 2617

assessible by other users of the network the present application contemplates what is described as published location information (see claim 68).

Claim 68 recites, "the method of claim 65, wherein the criteria of the at least one rule comprises location information of respective users of mobile stations".

Torvinen teaches the method of claim 65, wherein the criteria of the at least one rule comprises location information of respective users of mobile stations ("wish to form a group with each other for a certain time, purpose and location", Paragraph [0029], line 5; Paragraph [0016], lines 8-12). The limitation regarding publication is already discussed in claim 65.

Torvinen further teaches the above limitation in (paragraph [0055]), "the definition of region of interest (reads on location) may be established as a group formation criteria (read on one rule) to be enforced as a prerequisite to group membership as well as defining boundaries to be enforced during the group session".

Rejections under 35 U.S.C. 103(a)

Appellant argues that "Although Examiner states that Amir is an analogous art, broadcasting messages for a display on a telephone (as in Amir) and creating and managing a group for a group communication session (as in Torvinen) cannot fairly considered analogous".

Examiner respectfully disagrees. Appellant considered Amir as a prior art in his information disclosure statement (IDS) submitted on 9/27/2004 and therefore, it clearly shows that Amir is an analogous art as admitted by the appellant.

Art Unit: 2617

Rejection of claims Claims 66-67, 72 and 73 as being unpatentable under 35**U.S.C. 103(a) over Torvinen (US 2005/0113123) in view of Amir (WO 01/97539).**

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the reference of Amir is relied upon for the teaching of rule comprises at least one characteristic of respective users of mobile stations. The rule including characteristics of respective users provides further restriction in selecting the group by Torvinen. This acts as a filter, since it tries to organize group among subscribers with similar characteristic.

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Art Unit: 2617

Rejection of claims 76-78 as being unpatentable under 35 U.S.C. 103(a) over Torvinen (US 2005/0113123) in view of Griffin (US 7072941).

Appellant further argues that the rejection under Torvinen and Griffin is deficient for all the reasons argued above with respect to Torvinen. Specifically, Torvinen fails to teach or suggest a method that includes the steps of publishing information about one or more particular users of respective mobile stations to the communications network, and receiving at least one rule for defining a member of a group, where the at least one rule is defined by criteria comprising published information about respective users of mobile stations and is received in association with a group address. Griffin fails to cure these deficiencies.

The reference by Griffin is not relied upon for the above limitation, , since the reference by Torvinen teaches the above limitation as discussed above.

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In the present case, the Torvinen teaches group formation using location and other criteria associated with the participating terminals. Therefore, it would be obvious

Art Unit: 2617

to one of ordinary skill in the art to include specific criteria in order to select group members.

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Rejection of claim 85 as being unpatentable under 35 U.S.C. 103(a) over Torvinen (US 2005/0113123) in view of Laiho (US 6097942).

Appellant further argues that the rejection under Torvinen and Laiho is deficient for all the reasons argued above with respect to Torvinen. Specifically, Torvinen fails to teach or suggest a method that includes the steps of publishing information about one or more particular users of respective mobile stations to the communications network, and receiving at least one rule for defining a member of a group, where the at least one rule is defined by criteria comprising published information about respective users of mobile stations and is received in association with a group address. Laiho fails to cure these deficiencies.

The reference by Laiho is not relied upon for the above limitation, since the reference by Torvinen teaches the above limitation as discussed above.

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In the present case, Laiho teaches in an analogous art the method comprising receiving notification of individual matching mobile stations as the individual matching mobile stations are determined by said at least one server to hasten the populating (Abstract, lines 24-31; Col. 2, lines 33-41; lines 57-60). Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to use the method of claim comprising receiving notification of individual matching mobile stations as the individual matching mobile stations are determined by said at least one server to hasten the populating. This modification provides an efficient method of managing group communication.

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

Art Unit: 2617

reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Rejection of Claim 86 as being unpatentable under 35 U.S.C. 103(a) over Torvinen US 2005/0113123) in view of Chandhok (US 2004/0198376).

Appellant further argues that Torvinen fails to teach or suggest a method that includes the steps of publishing information about one or more particular users of respective mobile stations to the communications network, and receiving at least one rule for defining a member of a group, where the at least one rule is defined by criteria comprising published information about respective users of mobile stations and is received in association with a group address. Chandhok fails to cure these deficiencies.

The reference by Chandhok is not relied upon for the above limitation, since the reference by Torvinen teaches the above limitation as discussed above.

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In the present case Chandhok teaches in an analogous art, the method, further comprising receiving a change of the at least one rule and managing the members of the dynamic group in accordance with the change wherein the step of managing

Art Unit: 2617

comprises at least one of adding and removing members to the group (Paragraph [0022], line 6-7). This function helps in dynamically administering the management operation.

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Rejection of Claims 89-92 as being unpatentable under 35 U.S.C. 103(a) over Torvinen (US 2005/0113123) in view of Leigh et al. (US 5535426).

Appellant further argues that Torvinen fails to teach or suggest a method that includes the steps of publishing information about one or more particular users of respective mobile stations to the communications network, and receiving at least one rule for defining a member of a group, where the at least one rule is defined by criteria comprising published information about respective users of mobile stations and is received in association with a group address. Leigh fails to cure these deficiencies.

The reference by Leigh is not relied upon for the above limitation, since the reference by Torvinen teaches the above limitation as discussed above.

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Rejection of Claim 93 as being unpatentable under 35 U.S.C. 103(a) over Torvinen(US 2005/0113123) in view of Requena (US2002/0126701).

Appellant further argues that Torvinen fails to teach or suggest a method that includes the steps of publishing information about one or more particular users of respective mobile stations to the communications network, and receiving at least one rule for defining a member of a group, where the at least one rule is defined by criteria

Art Unit: 2617

comprising published information about respective users of mobile stations and is received in association with a group address. Requena fails to cure these deficiencies.

The reference by Leigh is not relied upon for the above limitation, since the reference by Torvinen teaches the above limitation as discussed above.

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Claims 94-102 and 103-112 have not been properly examined and the examiner has failed to establish a prima facie case of obviousness for Claims 94-102 and 103-112.

Art Unit: 2617

Claims 94-102 and 103-112 are not distinctly different from other claims examined. Therefore, the rejection of claims are proper.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Conclusion

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Muthuswamy G Manoharan/

Examiner, Art Unit 2617

Conferees:

/George Eng/

Supervisory Patent Examiner, Art Unit 2617

/VINCENT P. HARPER/

Supervisory Patent Examiner, Art Unit 2617